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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,446	06/05/2001	Davin J. Fifield	43576.830012.US1	5057

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01/04/2005

Brian Kinnear
Holland & Hart LLP
555 Seventeenth Street
Suite 3200
Denver, CO 80202

EXAMINER

SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,446

Applicant(s)

FIFIELD ET AL.

Examiner

Gautam Sain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1-1) Claims 1, 3-6, 7, 8, 9, 11-15, 17, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Smithies et al (US 6091835, filed Feb 1998).

Regarding claim 1, 7, 8, 9, 17 and 19, Smithies teaches a
computer useable medium and computer readable code embodied on said
computer useable medium for causing electronically signing an electronic transcript by a
user, the computer readable code comprising (ie., method and system for recording ...
transcripts ... party's electronic affirmation of a document...)(col 7, Summary section);

Smithies teaches

performing a first hash operation on the electronic transcript to
generate a representation of the contents of the electronic transcript (ie., transcript
generator ... hash corresponding to the content)(col 14, lines 5-20);

concatenating data to the representation of the contents of the electronic
transcript, said data identifying a user (ie., set the terms of document ... transcript
generator ... creates secure record)(col 12, lines 28-40)(ie., evidence to corroborate ...

transcript generation module collects)(col 13, lines 52-60)(see Fig 4b, item 518 shows a GUI that starts the process for gathering (equivalent to concatenating) data that represents the electronic transcript, upon approval, the data entered/verified is gathered);

performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data (ie., second hash code of transcript object)(col 14, line 33);

providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data (ie., Evidence ... Affirmation ... time ... transcript generator ... time stamp ... affirming party)(col 13, line 52 – col 14, line 4)(col 14, lines 18-20 talk about using timestamp as evidence, which must inherently be recorded along with the record if it is to be proper evidence);

obtaining a notary record from the digital notary service of the time stamping (ie., transcript object ... validity of affirmation process ... later use in verifying ... passed to client)(col 14, lines 48-60)(ie., the fact that the timestamp is used as evidence shows a record of when the timestamp was placed with the record)(col 14, line 1-5);

digitally signing the notary record (ie., ... Act of signing ...)(col 13, lines 52-67).

forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user (ie., client sends affirmation information to the transcript generator ... in lie 50 or col 14,

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the recording function gathers all the evidentiary components)(col 13, line 52 – col 14, line 67).

Regarding claim 3, 11, Smithies teaches “data includes ... user” (ie., affirming party ... identifying party entering affirming data ... password)(col 7, lines 23-30).

Regarding claim 4, 12, Smithies teaches “data includes ... the user” (ie., ... unique secret number ...)(col 7, lines 45-50).

Regarding claim 5, 13, Smithies teaches “data includes ... name” (ie., ... party’s name)(col 7, lines 50-52).

Regarding claim 6, 14, Smithies teaches “data ... identifies the transcript”(ie., identification data by system that transcript generator collects)(col 13, lines 52-60).

Regarding claim 15, Smithies teaches “ file contains ... transcript” (ie., transcript object can be encrypted in a statement file)(col 8, lines 25-30).

Claim Rejections - 35 USC § 103

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2-1) Claims 2, 10, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithies et al (as cited above), in view of Blake-Wilson et al (US 6336188, filed May 1998).

Regarding claim 2, 10, Smithies does not teach, but Blake-Wilson teaches “has operation is a RIPEMD-160 hash operation” (ie., hash function ... RIPEMD-160)(col 5, lines 25-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smithies to include RIPEMD hashing as taught by Blake-Wilson, providing the benefit of authentication key agreement protocols used in digital data communication systems (Blake-Wilson, col 1, lines 4-5, lines 60-65).

Regarding claims 16, 18, 20, Smithies teaches “file excludes page numbers, line numbers, headers, and footers” (ie., the transcript file does not indicate the presence of page numbers, line numbers, headers or footers)(Summary section). Additionally, has been very common to one of ordinary skill in the art at the time of the invention to use word processor software applications (ie., Microsoft Word,... etc) that allow for toggling page number, line numbers, headers and footers off and on depending on the user's choice.

Response to Arguments

Applicant's arguments filed 9/22/04 have been fully considered but they are not persuasive.

Remark 1 - 35 U.S.C. 102. Applicant traverses the rejection of claims 1, 3-6,7,8,9, 11-15, 17 and 19 and argues that said claims are not anticipated by the Smithies reference. The Examiner disagrees.

Applicant argues that Smithies does not teach any of the limitations of independent claims 1, 7, 8, 9, 17 and 19. The examiner disagrees and contends, upon

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further consideration, that Smithies teaches each and every limitation of claims 1, 7, 8, 9, 17 and 19. Generally, Smithies teaches a computer method and system for transcribing electronic affirmations. Specifically, Smithies teaches method and system for recording ... transcripts ... party's electronic affirmation of a document...)(col 7, Summary section); a transcript generator ... hash corresponding to the content (col 14, lines 5-20), set the terms of document ... transcript generator ... creates secure record)(col 12, lines 28-40); evidence to corroborate ... transcript generation module collects)(col 13, lines 52-60)(see Fig 4b, item 518 shows a GUI that starts the process for gathering (equivalent to concatenating) data that represents the electronic transcript, upon approval, the data entered/verified is gathered); second hash code of transcript object)(col 14, line 33); Evidence ... Affirmation ... time ... transcript generator ... time stamp ... affirming party (col 13, line 52 – col 14, line 4)(col 14, lines 18-20 talk about using timestamp as evidence, which must inherently be recorded along with the record if it is to be proper evidence); transcript object ... validity of affirmation process ... later use in verifying ... passed to client (col 14, lines 48-60)(ie., the fact that the timestamp is used as evidence shows a record of when the timestamp was placed with the record)(col 14, line 1-5); Act of signing ... (col 13, lines 52-67); client sends affirmation information to the transcript generator ... in lie 50 or col 14, the recording function gathers all the evidentiary components(col 13, line 52 – col 14, line 67).

Claims 3-6 depend on claim 1 and are not allowable. Claims 11-15 depend on claim 9 and are not allowable. Applicant argues that these claims are allowable

because they are dependants of respective independent claims. Examiner disagrees and Examiner maintains the rejection of these dependent claims.

Remark II – 35 U.S.C. 103. Applicant traverses the rejection of claims 2, 10, 16, 18 and 20 and argues that the claims are allowable for at least the same reasons as described with respect to the respective independent claims. Examiner disagrees and maintains the rejection of these dependent claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is **571-272-4096** (*new number*). The examiner can normally be reached on M-F 9-5 EST.

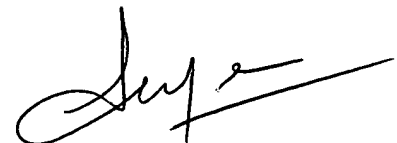
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GS

GS



SANJIV SHAH
PRIMARY EXAMINER